

### **REMARKS**

This Amendment is being filed in response to a Non-Final Office Action mailed on December 1, 2004.

Claims 1-16 and 34-75 are pending in the application.

Claims 1-16, 34-43, 50-54 and 57-75 stand rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter. Claims 1-11, 14-16, 34-38, 41 and 44-75 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,897,620 to Walker in view of the "Hawaiian Air to Offer Tickets Through ATMs" by Wall Street Journal ("Hawaiian Air").

Claims 1-16 are being amended. Claims 34-75 are being canceled for purposes of expediting prosecution of this application, but Applicant reserves the right to claim the subject matter of the canceled claims in a continuing application. Claims 1-16 will remain pending in the present application after entry of this amendment. No new matter is being introduced by way of the amendments. Applicant respectfully requests reconsideration of the Application in view of the amendments and remarks herein.

#### ***Remarks Regarding Claim Rejections under 35 U.S.C. § 101***

Claims 1-16, 34-43, 50-54, and 57-75 stand rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter.

Applicant is amending claims 1-16 to be directed to "a prepaid airline ticketing *system* ... comprising a processor ... and a storage device ... configured to store a record ... including a plurality of geographic flight parameters and a plurality of non-geographic flight parameters ... and an identifier ... uniquely identifying the record for the customer to use to exercise the pre-paid, fixed price option to book one of the flights." Applicant respectfully submits that claim 1, as amended, is directed to statutory subject matter because (1) the invention is within the technological arts (airline ticketing system, processor, storage device) and (2) the invention produces a useful, concrete, and tangible result (an identifier ... for the customer to use to exercise the pre-paid, fixed price option to book one of the flights ... for selection by the

customer for booking a flight). Claims 34-43, 50-54, and 57-75 are being canceled. Therefore, the rejection of claims 34-43, 50, and 52-54 under 35 U.S.C. § 101 is now moot. Applicant, therefore, respectfully requests withdrawal of the rejection of claims 1-16 under 35 U.S.C. § 101.

***Remarks Regarding Claim Rejections under 35 U.S.C. § 103***

Claims 1-11, 14-16, 34-38, 41 and 44-75 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Walker in view of Hawaiian Air.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. MPEP § 2143.

As recited in amended claim 1, Applicant's claimed invention are directed to:

“a prepaid airline ticketing *system* ... comprising a processor ... and a storage device ... configured to store a record ... including a plurality of geographic flight parameters and a plurality of non-geographic flight parameters ... and an identifier ... uniquely identifying the record for the customer to use to exercise the pre-paid, fixed price option to book one of the flights.”

In contrast to Applicant's system that allows the *customer* to exercise a pre-paid, fixed price option to book a flight from among a plurality of flights offered by one of multiple participating air travel carriers, Walker discloses a system by which airlines can fill seats that would otherwise remain empty (col. 3, lines 24-27). As disclosed in Walker at col. 2, line 30 - col. 3, line 23, a traveler specifies geographic flight parameters (*i.e.*, a departure location and a destination location) and a time range for travel. Based on the parameters specified by the traveler, an *airline assigns the traveler to a flight*. Thereafter, Walker's system issues a ticket with geographic flight parameters and flight times *specified* thereon.

Hawaiian Air discloses a system by which a given airline sells an open ticket to a customer for a future flight on that airline. The customer later uses the open ticket to book a Hawaiian Air flight.

Incorporating the Hawaiian Air open ticket into the system of Walker renders the system of Walker unworkable as a ticketing mechanism for an airline because the airlines of Walker must know the geographic and time parameters to assign a flight for the traveler. More specifically, the combination of the Walker system and the open ticket of Hawaiian Air is unworkable as the open ticket does not include an origination location or destination location and therefore would not allow the Walker system, which requires both the origination and destination locations, to book the flight. If the proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984).

Furthermore, if the Hawaiian Air open ticket were incorporated into the Walker system, a passenger would not be allowed to book a flight because Walker requires that the *airline* book the flight for the customer, as described above. Again, the combination of Walker and Hawaiian Air produces an unworkable system.

Moreover, there is no motivation to combine the assigned ticket of Walker into the open ticketing system disclosed by Hawaiian Air since that would render the open ticketing system inoperable. Once an airline, in cooperation with the Walker system, assigns the customer to a flight, the functionality of the open ticketing system of Hawaiian Air is defeated. If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. *In re Ratti*, 270 F. 2d 810, 123 USPQ 349 (CCPA 1959).

Even though the combined system of Walker and Hawaiian Air has been shown to be unworkable by Applicant in the arguments presented above, an example of a purchase of an "open ticket" disclosed by Hawaiian Air is now presented in view of a hypothetically combined system. A hypothetical customer purchases the open ticket for booking an inter-island flight on

Hawaiian Airlines from a Bank of Hawaii ATM machine. The customer thereafter logs onto the hypothetical combined system for booking a flight only to learn that the Walker system has already assigned a flight on Hawaiian Air at the time of purchase of the open ticket from the ATM. To reiterate, the Walker system is controlled by the airlines making the bookings, which is different from Applicant's amended claim 1 ("record representing a pre-paid, fixed price option purchased by a customer to be exercised by the *customer* to book a flight from among a plurality of flights offered by one of participating air travel carriers"). Conversely, if the hypothetical customer purchases an assigned ticket of Walker seeking flexibility and control for future travel on Hawaiian Air or any other airline, the hypothetical customer would again be disappointed to learn that the assigned ticket offers him, the customer, no flexibility or control. The limitations presented by the hypothetical system were addressed in background section of Applicant's application as originally filed (page 1, line 11 - page 2, line 16).

Continuing, if the hypothetical customer were to use the open ticket of Hawaiian Air for booking a flight on an Hawaiian Air flight as disclosed in the Hawaiian Air reference, then the hypothetical customer is limited to booking a flight only on Hawaiian Air and, therefore, does not teach, suggest, or provide motivation for each and every limitation as recited in amended claim 1 ("record representing a pre-paid, fixed price option ... to be exercised by the *customer* to book a flight from among a plurality of flights on one of *multiple* participating air travel carriers"). Even if Hawaiian Air includes partner airlines as stated in the Office Action on page 18, last sentence of the second full paragraph, Hawaiian Air would still assign the flight on the partner airline, as stated in paragraph 4 of the Hawaiian Air reference ("[c]ustomers will need to contact *Hawaiian Air* to reserve space on their desired flight, the carrier said."). In other words, the hypothetical customer has no flexibility or control in selecting an air travel carrier because Hawaiian Air must be contacted to book a flight and controls whether the customer flies on Hawaiian Air or one of its partner airlines. Therefore, the Hawaiian Air reference does not disclose and, Applicant argues, teaches away from Applicant's invention as recited in now amended claim 1 ("record representing a pre-paid, fixed price option ... to be exercised by the

customer to book a flight from among a plurality of flights on one of *multiple* participating air travel carriers").

Accordingly, Applicant respectfully submits that the rejection of amended claims 1-11 and 14-16 under 35 U.S.C. § 103(a) is improper for lack of a suggestion or motivation to combine Walker and Hawaiian Air. Therefore, Applicant requests withdrawal of the rejections under 35 U.S.C. § 103(a).

Claims 34-38, 41 and 44-75 are being canceled without prejudice. The rejections of claims 34-38, 41, and 44-75 under 35 U.S.C. 103(a) are therefore moot.

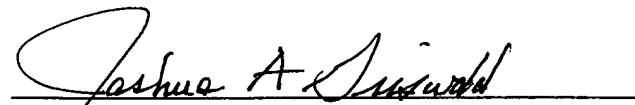
#### CONCLUSION

In light of the above, Applicant submits that the Application is in condition for allowance, and such a Notice is respectfully requested. If there are any outstanding issues, the Examiner is requested to telephone Applicant's counsel to resolve such issues.

No fees are believed due at this time. However, please apply any deficiencies or any other required fees or any credits to deposit account 06-1050, referencing the attorney docket number shown above.

Respectfully submitted,

Date: 3/1/05



Joshua A. Griswold  
Reg. No. 46,310

Fish & Richardson P.C.  
5000 Bank One Center  
1717 Main Street  
Dallas, Texas 75201  
Telephone: (214) 292-4034  
Facsimile: (214) 747-2091